

REMARKS

Status of the Claims

Claims 1-11, 13-22, 24-25 are pending. Applicants hereby cancel each of Claims 1-11, 13-22, 24-25 and instead present new Claims 26-48 for consideration.

Response to the Dual Rejection Under 35 U.S.C. §112, first paragraph, and Under 35 U.S.C. §101

Claims 1-15 have been dually rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure which is purportedly not enabling and under 35 U.S.C. §101 as being based on subject matter that lacks utility for purportedly failing to produce a “concrete” result. In particular, Claim 1, part (d) purportedly does not disclose how to properly select the appropriate data for a given emergency situation, and, as a result, would burden one skilled in the art with undue experimentation of selecting this data on a repeatable basis for a given emergency situation. In addition, Claim 1 purportedly fails to enable the method for preparing a checklist, and purportedly discloses that only facility data is stored in a hierarchy and spatial diagram. Applicants respectfully traverse this rejection of the claims and, for the reasons stated below, submit that a *prima facie* case has not been made to support a dual rejection under 35 U.S.C. §112, first paragraph, and under 35 U.S.C. §101. Moreover, even if a *prima facie* case is established, Applicants believe new independent Claims 26, 28, and 46 each overcome this rejection.

1. Applicants’ Invention Has Utility

For a proper rejection under 35 U.S.C. §101, “there must be a complete absence of data supporting the statements which set forth the desired results of the claimed invention.” *In re*

Cortright, 165 F.3d 1353, 1356 (Fed. Cir. 1999). The PTO cannot make a dual rejection under 35 U.S.C. §112, first paragraph, and under 35 U.S.C. §101 “unless it has reason to doubt the objective truth of the statements contained in the written description. *Id.* at 1356-1357. “Only after the PTO provides evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince such a person of the invention’s asserted utility.” *In re Brana*, 51 F.3d. 1560, 1566 (Fed. Cir. 1995); see also MPEP 2107.02 (IV) (“[T]he Office must (A) make a *prima facie* showing that the claimed invention lacks utility, and (B) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing.”) (emphasis added).

In this case, Applicants respectfully submit that the purported failure of the invention to produce a “concrete” result is entirely conclusory, resulting in a rejection that was made without any supporting evidence whatsoever to show that Applicants’ results are irreproducible. Put another way, Applicants respectfully submit that the Office Action lacks any evidence to support the contention that the action of selecting input data results in a method that lacks utility. Consequently, the citation in the Office Action to *In re Swartz*, 232 F.3d 862, 864 (Fed. Cir. 2000), is inapplicable in this case because unlike here, the PTO in *Swartz* provided substantial evidence showing that the results in the area of cold fusion were irreproducible to support the contention that the invention was inherently unbelievable, and therefore, lacked utility.

Not only does the Office Action lack any evidence to support the contention that Applicants’ method lacks utility, but there is nothing in the written description that “suggest[s] an inherently unbelievable undertaking or involve[s] implausible scientific principles,” as would

be necessary for a proper rejection under 35 U.S.C. §101, to find reason to doubt the asserted utility of Applicants' invention. *In re Brana*, 51 F.3d. at 1357.

In addition, the MPEP and the case law provide that, when evaluating the scope of a claim, every limitation in the claim must be considered. It is impermissible, therefore, to dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. *See, e.g., Diamond v. Diehr*, 450 U.S. 175, 188-89 (1981) ("In determining the eligibility of respondents' claimed process for patent protection under 101, their claims must be considered as a whole."); MPEP 2106 II-C, p. 2100-8, Rev. 5, Aug. 2006.

But an impermissible dissection of Claim 1 is exactly what appears to have occurred in this case. For example, rather than taking Claim 1 as a whole to evaluate the asserted utility of the invention, a conclusion of lack of utility appears to have been made on the basis of the limitation expressed in Claim 1 (d) alone -- apart from the entirety of Claim 1. *See*, Office Action at page 4. For all of these reasons, Applicants respectfully submit that a *prima facie* case has not been made to justify the rejection of the claims under 35 U.S.C. §101. Reconsideration and withdrawal of the rejection of the claims, and allowance of Claims 26, 38, and 46, is respectfully requested.

Even if a *prima facie* case exists under 35 U.S.C. §101, which Applicants traverse, Applicants respectfully submit that the present invention, as claimed in new independent Claims 26, 38, and 46, has both specific utility and substantial utility to satisfy the requirements of 35 U.S.C. §101. In particular, Applicants' invention has specific utility because it is useful in providing emergency planners and responders with a method for generating a time-phased

response to both small or large-scale emergencies based on known values for existing resources. See, e.g., page 16 at [0062]. With this method, emergency planners and responders will know ahead of time certain details of the emergency scene to effectively deal with the emergency in the most efficient manner possible under potentially rapidly changing circumstances. See, e.g., pages 2-3 at [0009-0011]. In addition, Applicants' method provides emergency planners and responders with a plurality of flexible, updatable data entry and retrievable interfaces that permit entry and recall of a host of disparate forms of data, including real-time situational awareness data comprising photos documenting the extent of damage resulting from, for example, a natural disaster. See, e.g., pages 12-13 at [0044-0049]. Applicants' invention, therefore, has specific utility and results from a combination of features that are not present in the prior art.

Applicants' invention also has substantial utility because Applicants' invention carries out a present real-world use. Today, communities are faced with the monumental task of ensuring that they are adequately prepared for major events, and there are no presently known tools available to the public to effectively and efficiently deal with a facility, community, or region-wide crisis, as claimed in the present application. Applicants' invention satisfies this need by providing a solution that integrates information from a variety of sources with a method for generating a time-phased response to an emergency.

Moreover, independent Claims 26, 38, and 46 each claim subject matter that provides a user of the invention useful and reasonably repeatable results. Claim 26, for example, replaces the step of "selecting data within said hierarchy and said spatial diagrams necessary to assess said emergency situation," formerly specified in Claim 1, with the step of "estimating a quantity of people likely to be affected by the emergency situation to characterize the scope of the

emergency situation.” Applicants respectfully submit that one of ordinary skill in the art, such as an emergency response planning expert, would have the experience and training necessary to execute this step to yield reliable, useful, and reasonably repeatable results.

For these reasons, Applicants’ invention satisfies the requirements for patentable subject matter under 35 U.S.C. §101. Reconsideration and withdrawal of the rejections of Claims 1-11, 13-22, 24-25, now presented as new Claims 26-48, is respectfully requested.

2. Applicants’ Written Description Is Enabling

Applicants further submit that the PTO has not established a *prima facie* case of nonenablement under 35 U.S.C. §112, first paragraph. In particular, the Office Action does not include any evidence whatsoever to support the conclusion that Applicants have not disclosed how to properly select the appropriate data for a given emergency situation, and, as a result, would burden one skilled in the art with undue experimentation of selecting the same on a repeatable basis.

But even if a *prima facie* case exists, which Applicants traverse, Applicants’ written description nevertheless satisfies the “how to use” prong under 35 U.S.C. §112, first paragraph. In particular, Applicants submit that one of ordinary skill, such as an emergency response planning expert having experience in the field of disaster contingency planning and preparedness programs at either the local, regional, or national level, would be able to select and/or enter reasonably accurate input data to yield reasonably accurate output data.

Moreover, in new independent Claim 26, as described above, Applicants have replaced the step of “selecting data within said hierarchy and said spatial diagrams necessary to assess said emergency situation,” formerly specified in Claim 1, with the step of “estimating a quantity

of people likely to be affected by the emergency situation to characterize the scope of the emergency situation.” The disclosure supports this limitation on Fig. 10 and on page 15 at [0058] of the specification:

[After identifying the type of the emergency situation, the] user is next presented with a characterization page specific to the selected contingency. This page is used to collect information useful in characterizing the selected contingency. For example, in the case of a biological attack, the potential number of people exposed is a key consideration, as is the number of hospital beds available in the city.

Applicants submit that one of ordinary skill, such as an emergency response planning expert, is trained to know, and be able to estimate with reasonable precision, the quantity of people likely to be affected by any particular emergency situation. Thus, the step of estimating a quantity of people likely to be affected by the emergency situation to characterize the scope of the emergency situation, when this limitation is viewed in the context of the entire claim, enables one of ordinary skill to practice the invention without undue experimentation.

To further support this contention, Applicants respectfully submit the Declaration of James L. Bowden, an expert in the field of disaster planning and response. Mr. Bowden currently serves as an assessor for the national Emergency Management Accreditation Program (EMAP), which is an independent non-profit corporation with no affiliation to Applicants that assists state and local governments in establishing emergency management programs that meet EMAP standards. Applicants believe Mr. Bowden’s Declaration, together with new independent Claims 26, 38, and 46, overcome the rejection under 35 U.S.C. §112, first paragraph, because the invention, as claimed, will enable one of ordinary skill to properly select reasonably accurate input to result in concrete and reasonably repeatable output data.

Lastly, Applicants submit that one of ordinary skill in the art, given the hindsight of Applicants' enabling disclosure, can create a Responder Assets Management System (RAMS) software program and database that performs the steps and functions of Applicants' invention without undue experimentation so as to satisfy the "how to use" prong under 35 U.S.C. §112, first paragraph. In particular, Applicants' invention employs standard techniques for modular software coding and personal computer hardware. For example, creating hyperlinks for accessing local or national weather over the Internet, creating object-based and/or hierarchical information tree interfaces for users, and programming decision-making logic for generating an emergency response plan given available resources, are all well within the knowledge of a skilled artisan.

For all of these reasons, Applicants respectfully submit that the written description enables one of ordinary skill in the art to make and use the invention without undue experimentation, in accordance with 35 U.S.C. §112, first paragraph.

In view of the foregoing, Applicants' respectfully submit that a *prima facie* case has not been made to support a dual rejection under 35 U.S.C. §112, first paragraph, and under 35 U.S.C. §101. And, even if a *prima facie* case is established, Applicants believe independent Claims 26, 38, and 46, together with the entire disclosure in the present application, satisfies 35 U.S.C. §112, first paragraph and 35 U.S.C. §101. Reconsideration and withdrawal of the rejections of Claims 1-11, 13-22, 24-25, now presented as new Claims 26-48, is respectfully requested.

Rejection Under 35 U.S.C. §112, second paragraph

Claims 1-15 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. In particular, Claim 1 purportedly includes a “step f” when there are purportedly no “steps a-e,” and the term “and/or” in Claim 1 renders this claim indefinite.

In response, Applicants have removed any reference to the term “and/or” in the claims. In addition, none of the claims enumerate a “step f.” In so doing, Applicants respectfully submit that they have overcome the rejection of the claims under 35 U.S.C. §112, second paragraph. Reconsideration and withdrawal of the rejections to the claims, and allowance of Claims 26-48, is respectfully requested.

Rejections Under 35 U.S.C. §102(a) and Under 35 U.S.C. §103(a)

Claims 1-7, 9-11, 13-22, and 24-25 have been rejected under 35 U.S.C. §102(a) as being anticipated by Quick (U.S. Publication No. 2001/0056435A). Claim 8 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Quick in view of Associated Realty Property Management (<http://web.archive.org/web/20000817071152/http://www.arpm.com/>). Applicants respectfully traverse these rejections of the claims.

Quick discloses a system, method, and apparatus that accesses a database containing information on, among other things, a building and its contents. In particular, Quick teaches the use of “pre-plan” comprising specific details of a particular building and its hazardous materials for later recall by emergency personnel while en route to an emergency at that particular building. The system, method, and apparatus disclosed in Quick is limited, however, to static data residing in a database and the recall of that data by emergency personnel. Quick does not, for example, teach or disclose generating a response to an emergency situation comprising a

time-phased list of actions and resources needed for each increment of time over a predicted duration of the emergency situation.

By contrast, Applicants invention of independent Claims 26, 28, and 46 each include the requirement of generating a response to the emergency situation comprising a time-phased list of actions needed and time phased list of resources needed for each increment of time over a predicted duration of the emergency situation. On this basis, Applicants believe independent Claims 26, 28, and 46 overcome the rejection under 35 U.S.C. §102(a). Reconsideration and withdrawal of the rejections to the claims, and allowance of Claims 26, 38, and 46, is respectfully requested.

As dependent Claims 27-37, 39-45, and 47-48 merely serve to further define the subject matter of independent Claims 26, 38, and 46, which themselves should be deemed allowable, reconsideration and withdrawal of the rejection of the claims, and allowance thereof, is respectfully requested.

Conclusion

Applicants believe that they have overcome the stated rejections and have placed the application in condition for allowance. Early notification of allowance of the claims is respectfully requested. The Examiner is invited to contact the undersigned if the Examiner feels a telephonic conference would expedite the allowance of the present application.

In re Application of: McKenney et al.
Application No.: 10/038,572
Attorney Docket No.: 19558.01US1

Examiner: Gerardo Araque Jr.
Art Unit: 3629

Respectfully submitted,

Date: June 15, 2007

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